

## **REMARKS**

### **I. INTRODUCTION**

Claims 1, 8, 16, 23, 30 and 38 have been amended to broaden the exemplary claimed subject matter of the present application. Claims 5, 6, 13, 17, 22, 35, 39, 44, 45 and 48 have been amended merely remove minor informalities therefrom. The amendments to the claims have not been made for any reasons relating to patentability thereof. Claims 1-53 are under consideration in the above-referenced application. Provided above, please find a claim listing indicating the current amendments to claims 1, 5, 6, 8, 13, 16, 17, 22, 23, 30, 35, 38, 39 and 44. Applicants respectfully assert that the amendments to the claims and the additional new claims fully comply with the requirements set forth in 37 C.F.R. § 1.121. It is respectfully submitted that no new matter has been added.

### **II. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH SHOULD BE WITHDRAWN**

Claims 1-53 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. The Examiner alleges that the specification as originally filed contains no support for “being performed” in independent claims 1, 23, 30 and 38. (See Office Action, p. 2, last paragraph).<sup>1</sup>

Applicants respectfully disagree with this allegation provided by the Examiner. Indeed, it is believed that the support for such recitation of an activity “being performed” is provided in the specification, e.g., on page 5, line 21 through page 6, line 6 (which describes an exemplary embodiment of the present invention by which any activity occurring at the card terminal may be monitored in real-time), and in Fig. 6, via elements 129 and 131 (illustrating a continuous loop to

monitor a terminal for a particular activity). Applicants respectfully assert that these descriptions provide support for the recitation of detecting an activity being performed at a card terminal.

However, independent claims 1, 23, 30 and 38, have been amended to remove this recitation and to broaden the scope of these claim in order to expedite prosecution of the present application, and not for any reasons relating to patentability thereof. Applicants have also amended independent claims 8 and 16 above in a similar manner to remove this recitation for the same reasons.

Accordingly, Applicants respectfully request that this rejection of pending claims 1-18 and 21-53 under 35 U.S.C. § 112, first paragraph be withdrawn.

### **III. REJECTION UNDER 35 U.S.C. § 103(a) SHOULD BE WITHDRAWN**

Claims 1-53 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,877,093 issued to Desai et al. (the “Desai patent”), in view of either U.S. Patent No. 6,707,892 issued to Kawagishi (the “Kawagishi patent”) or U.S. Patent No. 6,644,553 issued to Ohki et al. (the “Ohki patent”), and U.S. Patent No. 6,507,909 issued to Zurko et al. (the “Zurko patent”). (See Office Action dated March 27, 2006, page 3, second paragraph). It is respectfully asserted that the alleged combination of the Desai patent with any of the Kawagishi patent or the Ohki patent, along with the Zurko patent fails to teach or suggest the subject matter recited in amended independent claims 1, 8, 16, 23, 30, and 38, and the claims which depend therefrom.

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<sup>1</sup> The Examiner did not specifically refer to independent claims 8 and 16, which also contain such phrase in this rejection of claims 1-53, but Applicants assume that the Examiner intended to refer to claims 8 and 16 in such rejection, and thus this section addresses these claims as well.

A. Claims 1-7, 45 and 46

Applicants' invention, as recited in amended independent claim 1, relates to a method for downloading an application to a card terminal which comprises, *inter alia*, **monitoring the card terminal to detect at least one activity performed at the card terminal, and upon detecting the activity performed at the card terminal, electronically transmitting to the card terminal information related to the request for use in downloading the application to the card terminal**. It is respectfully asserted that at least these recitations are not taught or suggested by the Desai patent, in combination with either of the Kawagishi patent or the Ohki patent, along with the Zurko patent.

The Desai patent describes a transaction processing device and system that is capable of, *inter alia*, being configured remotely using a secure connection. The configuration of the device described in the Desai patent occurs independently of any monitoring of the device or detection of an activity being performed at the device, and there is no transmission of information relating to a download request based on detection of such activity as recited in claim 1. (See, e.g., Desai patent, col. 3, line 61 through col. 4, line 31; and Fig. 8).

The Examiner cites the Kawagishi patent and the Ohki patent to show downloading of application programs by card terminals. The Kawagishi patent describes an IC card terminal device that is capable, *inter alia*, of initiating a request to download a required application if it does not have such application stored in its memory. (See, e.g., Kawagishi patent, col. 2, lines 6-31; col. 5, lines 26-49; and Fig. 7).

The Ohki patent describes a portable IC card terminal that is capable of, *inter alia*, downloading a required application from a network if the required application is not present in the memory of an inserted IC card. (See, e.g., Ohki patent, col. 2, lines 9-17; col. 6, lines 18-35; and Fig. 17).

However, these references fail to cure the deficiencies of the Desai patent. Neither of these references teaches or suggests monitoring of activity at the terminal or the transmission of information based on detection of such activity, as recited in claim 1.

The Examiner cites the Zurko patent to cure these deficiencies, and alleges that the Zurko patent shows, for purposes of security in financial terminals, monitoring of terminal activity is a normal process, and believes that it would have been obvious to one of ordinary skill in this art to provide a similar arrangement for the system described in the Desai patent because “configuration downloads are conventional functional equivalents of the claim limitations and security is a necessity in card terminal processes.” (See Office Action, page 4, lines 4-11).

Applicants respectfully assert that the Zurko patent does not cure the deficiencies of the Desai patent in combination with either the Kawagishi patent or the Ohki patent. The Zurko patent describes a method for allowing a secure access to a computing system from a terminal. In particular, the Zurko patent only describes granting a secure access to the computer system upon the activation of a “secure attention key.” (See Zurko patent, column 4, line 66 through column 5, line 7; column 7, lines 58-62; and column 8, line 54 through column 9, line 4). The Zurko patent does not teach or suggest transmitting of any information to a terminal, much less that any such transmitting is provided upon detecting an activity performed at the terminal. Thus, the alleged combination of references cited by the Examiner fails to teach or suggest transmitting certain information to a card terminal in response to an activity detected at the terminal as recited in amended independent claim 1.

Claims 2-7, 45 and 46 depend from independent claim 1, and are thus also allowable over the Desai patent, in combination with either the Kawagishi patent or the Ohki patent, and with the Zurko patent.

Further, with respect to claims 5 and 46, Applicants respectfully assert that none of the references cited by the Examiner teach or suggest *monitoring of a card terminal to detect a closing of a batch job or a request to process a transaction, and transmitting information to the terminal upon detection of one or more of these activities*, as recited in these claims.

Thus, for at least the reasons provided above, Applicants respectfully assert that claims 1-7, 45 and 46 are patentable over the alleged combination of references relied on by the Examiner, and request that the rejection of claims 1-7, 45 and 46 under 35 U.S.C. § 103(a) be withdrawn.

B. Claims 8-15 and 47

Applicants' invention, as recited in amended independent claim 8, recites a method for providing configuration data to a card terminal which comprises, *inter alia*, **monitoring the card terminal to detect at least one activity performed at the card terminal, and electronically transmitting the configuration data to the card terminal upon detection of the activity performed at the card terminal** in order to reconfigure the card terminal. It is respectfully asserted that at least these recitations are not taught or suggested by the combination of the Desai patent with the Kawagishi patent or the Ohki patent, together with the Zurko patent.

In the Office Action, the Examiner alleges that the Zurko patent shows that for purposes of security in financial terminals, monitoring of terminal activity is a normal process, and that it would have been obvious to one of ordinary skill in this art to provide a similar arrangement for the system described in the Desai patent because "configuration downloads are conventional functional equivalents of the claim limitations and security is a necessity in card terminal processes." (See Office Action dated March 27, 2006, page 6, lines 4-12).

Applicants respectfully assert that the Zurko patent does not cure the deficiencies of the Desai patent as combined with either the Kawagishi patent or the Ohki patent to teach or suggest

Applicants' invention as recited in independent claim 8. As described above with reference to amended independent claim 1, Applicants respectfully assert that the Zurko patent does not teach or suggest transmitting any information (including configuration data) to a terminal, much less that any such transmitting is provided upon detecting an activity performed at the terminal. Thus, the alleged combination of references cited by the Examiner fails to teach or suggest downloading configuration data to a card terminal in response to an activity detected at the terminal, as recited in amended independent claim 8. Claims 9-15 and 47 depend from independent claim 8, and are thus also allowable over the Desai patent, in combination with either the Kawagishi patent or the Ohki patent, and with the Zurko patent.

Further, with respect to claim 47, Applicants respectfully assert that none of the references relied on by the Examiner teach or suggest **monitoring of a card terminal to detect a closing of a batch job or a request to process a transaction, and transmitting configuration data to the terminal upon detection of one of these activities**, as recited in this claim.

Thus, for at least the reasons provided above, Applicants respectfully assert that claims 8-15 and 47 are patentable over the prior art cited by the Examiner, and request that the rejection of claims 8-15 and 47 under 35 U.S.C. § 103(a) be withdrawn.

C. Claims 16-22, 48 and 49

Applicants' invention, as recited in amended independent claim 16 recites a method for providing information regarding activity at a card terminal to a remote network connection which comprises, *inter alia*, **monitoring the card terminal to detect at least one activity performed at the card terminal, and generating information relating to the activity upon detection of the activity performed at the card terminal** for network transmission and display.

It is respectfully asserted that at least these recitations are not taught or suggested by the combination of the Desai patent with the Kawagishi patent or the Ohki patent, together with the Zurko patent.

The alleged combination of the Desai patent with the Kawagishi patent or the Ohki patent fails to teach or suggest monitoring of a card terminal to detect an activity, and also does not teach or suggest generating information relating to the activity for network transmission and display, as recited in claim 16.

Applicants respectfully assert that the Zurko patent does not cure the deficiencies of the Desai patent as combined with either the Kawagishi patent or the Ohki patent to teach or suggest Applicants' invention as recited in independent claim 16. Applicants respectfully assert that the Zurko patent does not teach or suggest generating information related to an activity detected at a terminal for network transmission and display, much less that any such generating is provided upon detecting the activity performed at the terminal. as recited in amended independent claim 16.

Claims 17-22, 48 and 49 depend from independent claim 16, and are thus also allowable over the Desai patent, in combination with either the Kawagishi patent or the Ohki patent, and with the Zurko patent.

Further, with respect to claim 49, Applicants respectfully assert that none of the references relied on by the Examiner teach or suggest **monitoring of a card terminal to detect a closing of a batch job or a request to process a transaction, and generating information relating to that activity for network transmission and display upon detecting the activity**, as recited in this claim.

Thus, for at least the reasons provided above, Applicants respectfully request that the rejection of claims 16-22, 48 and 49 under 35 U.S.C. § 103(a) be withdrawn.

D. Claims 23-29, 50 and 51

Applicants' invention, as recited in amended independent claim 23 recites an apparatus that is capable of performing the procedures recited in amended independent claim 1. Claims 24-29, 50 and 51 depend from independent claim 23. Thus, for at least the reasons provided above in Section A with respect to claims 1-7, 45 and 46, Applicants respectfully assert that claims 23-29, 50 and 51 are allowable over the references relied on by the Examiner.

Further, with respect to claims 27 and 51, Applicants respectfully assert that none of the references relied on by the Examiner teach or suggest **monitoring of a card terminal to detect a closing of a batch job or a request to process a transaction, and transmitting information relating to a download request to the terminal upon detection of one of these activities**, as recited in these claims.

Applicants accordingly request that the rejection of claims 23-29, 50 and 51 under 35 U.S.C. § 103(a) be withdrawn.

E. Claims 30-37 and 52

Applicants' invention, as recited in amended independent claim 30 recites an apparatus that is capable of performing the procedures recited in amended independent claim 8. Claims 31-37 and 52 depend from independent claim 30. Thus, for at least the reasons provided above in Section B with respect to claims 8-15 and 47, Applicants respectfully assert that claims 30-37 and 52 are allowable over the references cited by the Examiner.

Further, with respect to claim 52, Applicants respectfully assert that none of the references cited by the Examiner teach or suggest **monitoring of a card terminal to detect a closing of a batch job or a request to process a transaction, and transmitting configuration data to the terminal upon detection of one of these activities**, as recited in this claim.



Applicants accordingly request that the rejection of claims 30-37 and 52 under 35 U.S.C. § 103(a) be withdrawn.

F. Claims 38-44 and 53

Applicants' invention, as recited in amended independent claim 38 recites an apparatus that is capable of performing the procedures recited in independent claim 16. Claims 37-44 and 53 depend from independent claim 38. Thus, for at least the reasons provided above in Section C with respect to claims 16-22, 48 and 49, Applicants respectfully assert that claims 38-44 and 53 are allowable over the references cited by the Examiner.

Further, with respect to claim 53, Applicants respectfully assert that none of the references cited by the Examiner teach or suggest **monitoring of a card terminal to detect a closing of a batch job or a request to process a transaction, and generating information relating to that activity for network transmission and display upon detecting the activity**, as recited in this claim.

Applicants accordingly request that the rejection of claims 38-44 and 53 under 35 U.S.C. § 103(a) be withdrawn.

G. Summary

Therefore, Applicants respectfully submit that the alleged combination of the Desai patent with any of the Kawagishi patent or the Ohki patent, and with the Zurko patent fails to teach or suggest the subject matter recited in pending claims 1-53. Thus, withdrawal of the rejection of these claims under 35 U.S.C. § 103(a) is respectfully requested.

#### **IV. CONCLUSION**

In view of the above, it is respectfully submitted that pending claims 1-53 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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